

## **REMARKS**

The present amendment is in response to the Office Action dated January 26, 2006. Claims 1-31 are now present in this case. No claims are amended in this response. However, all claims are included for the Examiner's convenience.

Claims 1 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,301,514 to Canada, U.S. Patent No. 5,289,160 to Fiorletta, and U.S. Patent No. 6,885,862 to Pearson. The applicants respectfully reverse this rejection and request reconsideration.

The Office Action combines the teachings of three separate references in reaching the conclusion that Claims 1 and 9 are obvious. The Office Action, at pages 2-3, asserts that Canada teaches a polling method but does not specifically disclose repeating the receiving and sending on a regular basis. The Office Action further asserts that Fiorletta teaches repeating the receiving and sending on a regular basis. Finally, the Office Action states that the combination of Canada and Fiorletta does not disclose a wireless transceiver unit and wireless base station sending information over a control channel in response to an information request message. The Office Action asserts that Pearson teaches such communication over a wireless control channel.

It is noted that each of these three references are classified in completely different classifications by the United States Patent and Trademark Office. The Patent and Trademark has recognized the different and distinct art fields between these three references: Canada is classified under U.S. Classification 700/108, 700/109, and 700/110 for data processing and performance monitoring, quality control, and defect analysis or recognition, respectively. Canada is also classified under Class 340/825.06 and 340/825.08 for international patent references for electrical communications and selective monitoring and supervisory controlling and selective polling, respectively. In contrast, Fiorletta is classified under Class 340/447, 340/442, 340/445, 340/539, and 340/825.54 for RF electrical communications for tire deflation/inflation with telemetric coupling, a condition responsive indicating system, and foreign patent references for interrogation response, respectively. Fiorletta is also classified in Class 73/146.5 and 73/146 for measurement and testing of tire, tread, or roadway with electrical communication, respectively. Fiorletta is further classified in Class 116/34R for signals

and indicator of vehicle motion and direction. In yet another unrelated classification, Pearson is classified in Class 455/418, 455/419, 455/458, 455/500, and 455/503 for telecommunications radio telephone systems for remote programming control, paging in a multi-station system, and simulcast system, respectively. In summary, there are no classifications in common between any of the three primary references cited in the Office Action. Furthermore, the fields of search of each of the three primary references are also completely different. One of ordinary skill in the art would be extremely unlikely to select references from disparate classifications to reach the combination suggested in the Office Action.

In proceedings before the Patent and Trademark Office, the Examiner has the burden of establishing a *prima facie* case of obviousness based on the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984). It is a well settled rule of law that there must be some motivation, suggestion or teaching of the desirability of making a specific combination recited in the rejected claims and that teachings of references can be combined only if there is some suggestion or incentive to do so. *See e.g., In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988); and *ACS Hosp. Sys., Inc. v. Montesiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The need for specificity is critical and particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998).

With respect to the present application, the Office Action lacks any discussion of any objectively verifiable motivation for combining the teachings of Canada, Fiorletta, and Pearson. The Office Action states that it would be obvious to combine Fiorletta and Canada “in order to warn a driver of a vehicle low pressure in one or more of its tires so that the driver may take corrective action before a tire blowout occurs.” (See Office Action, page 3.) This is the motivation for the creation of the technology disclosed in Fiorletta, but does not suggest any motivation to modify and/or combine Fiorletta with Canada as suggested in the Office Action. Similarly, the Office Action states that it would have been obvious to combine the teaching of Pearson into

the system of Canada and Fiorletta “in order to provide non-volatile storage of a partial program within each wireless subscriber terminal so that the wireless subscriber terminal need not receive an entire program in a single session.” This is the motivation for the creation of the technology disclosed in Pearson, but does not suggest any motivation to modify and/or combine the teachings of Pearson with those of Canada and Fiorletta.

Making a determination regarding obviousness, 35 U.S.C. § 103 requires consideration of the claim as a whole and prohibits breaking “an invention into its component parts (A+B+C), then finding a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious.” *Ruiz v. A.B. Chance Co.*, 69 USPQ 2d 1686, 1690 (Fed. Cir. 2004). Despite the prohibition on piecemeal analysis, it appears that the Office Action is based entirely on this exact form of analysis with respect to Claims 1 and 9. It is noted that the Office Action uses three separate references to reject portions of Claims 1 and 9, but never provides any motivation for combining the references and, therefore, does not consider the claim as a whole, as required by law.

Consequently, it is believed that the applicants’ patent application has been used as a template to piece together references in attempt to reject the pending claims and that this attempt fails because these references do not lend themselves to be combined or modified with each other to read on the claimed invention. As noted above, Canada, Fiorletta, and Pearson are not of the same analogous art and are classified by the Patent Office in different classifications. The applicants respectfully point out that nowhere has the Office Action pointed to any objectively verifiable motivation to modify and/or combine the teachings of the art of records to produce the claimed invention beyond the bare assertion of obviousness.

Accordingly, applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine or modify. In the absence of objectively verifiable motivation to modify and/or combine the art of record to reach the applicants’ claims at issue, no *prima facie* case of unpatentability has been established.

Accordingly, applicants respectfully request that the Examiner allow the pending claims for at least this reason.

Claims 2, 3, 5, 8, 10, 11, and 14-17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada, Fiorletta, Pearson, and U.S. Patent No. 5,315,636 to Patel. The applicants respectfully traverse this rejection and request reconsideration.

The applicants have already discussed the inapplicability of the combination of Canada, Fiorletta, and Pearson, as discussed in detail above. It is noted that the Office Action adds yet a fourth reference in another unrelated field as the basis for rejection of claims 2, 3, 5, 8, 10, 11, and 14-17. Specifically, Patel is classified by the U.S. Patent Office in Class 379/58, 379/59, 379/60, and 379/63 for telephonic communications, which is now classified in Class 455/306 for a zoned or cellular communications system with hand-off control. It is noted that this is unrelated to the classifications of the three primary references. There are no overlapping classifications or fields of search. One skilled in the art is highly unlikely to combine four separate references from four different patent classifications as suggested in the Office Action.

The Office Action makes a bare assertion that would be obvious to combine the teachings of Patel into the system of Canada, Fiorletta, and Pearson “in order to enable a caller to contact a system subscriber at any location.” This is not a motivation to combine references, as required by law, but merely states the motivation for Patel to create the invention of Patel. Therefore, no *prima facie* case of obviousness has been established. Applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine and/or modify four different references that have been classified by the U.S. Patent Office in four different classifications. In the absence of objectively verifiable motivation to modify and/or combine the art of record to reach the applicants’ claims at issue, no *prima facie* case of unpatentability has been established. Accordingly, applicants respectfully request that the Examiner allow claims 2, 3, 5, 8, 10, 11, and 14-17.

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada, Fiorletta, Pearson, and U.S. Patent No. 5,937,358 to Gehrig. The applicants respectfully traverse this rejection and request reconsideration.

The inappropriate combination of the primary references Canada, Fiorletta, and Pearson has already been discussed in detail above. For the sake of brevity, those arguments need not be repeated herein. However, it is further noted that Gehrig has a U.S. Patent classification and a field of search containing no overlapping class with any of the three primary references. One skilled in the art is highly unlikely to combine four separate references from four different patent classifications as suggested in the Office Action.

The Office Action asserts, at page 6, that it would have been obvious to combine the teaching of Gehrig into the system of Canada, Fiorletta, and Pearson “to provide a method and device for communication in traffic guidance systems in that data and voice channels reserved for traffic operation can be better utilized.” Again, the Office Action provides only a motivation for Gehrig to create the invention of Gehrig, but provides no objective evidence or rationale for combining Gehrig with Canada, Fiorletta, and Pearson. In view of the complete lack of any objectively stated motivation to combine and/or modify the references, there is no *prima facie* case of obviousness with respect to claims 4 and 12. Accordingly, the applicants respectfully request the allowance of claims 4 and 12 for at least this reason.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada, Fiorletta, Pearson and U.S. Patent No. 6,014,374 to Paneth. The applicants respectfully traverse this rejection and request reconsideration.

The inapplicability of the combination of the primary references Canada, Fiorletta, and Pearson have already been discussed in detail above. For the sake of brevity, those arguments need not be repeated herein. However, it should be noted that the addition of Paneth as a fourth reference in the rejection of claims 6-7 is wholly unsupported in the Office Action. There is no objectively verifiable motivation to modify and/or combine the references. The Office Action makes the bare assertion, at page 6, that it would have been obvious to provide the teaching of Paneth into the system of Canada, Fiorletta, and Pearson “to provide a system for the wireless transmission of

multiple information signals utilizing digital time division circuits between a base station and subscriber stations.” The Office Action merely describes the motivation for Paneth to create the invention of Paneth. This is not a motivation to combine Paneth with other references as asserted in the Office Action. In the absence of any objectively verifiable suggestion to modify and/or combine the references, the Office Action has not established a *prima facie* case of obviousness. The applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine or modify. In the absence of objectively verifiable motivation to modify and/or combine the art or record, no *prima facie* case of unpatentability has been established. Accordingly, the applicants respectfully request the Examiner allow claims 6 and 7 for at least this reason.

Claim 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada, Fiorletta, Pearson and U.S. Patent No. 6,347,092 to Serikawa et al. The applicants respectfully traverse this rejection and request reconsideration.

The inapplicability of the combination of the primary references Canada, Fiorletta, Pearson have already been discussed in detail above. However, it should be noted that Serikawa is classified in a U.S. classification and has field of search with no overlap between the classification and fields of search of the three primary references Canada, Fiorletta, and Pearson. Thus, one skilled in the art would be unlikely to combine four references from four different Patent Office classifications in the manner suggested in the Office Action.

Furthermore, the Office Action presents no *prima facie* case of obviousness in support of the combination of references. As discussed in detail above, the Examiner has the responsibility to establish a *prima facie* case of obviousness. It is noted that the Office Action provides no objectively verifiable motivation to modify and/or combine the teachings of the art of record to produce the claimed invention beyond the bare assertion of obviousness. The Office Action states, at page 7, that it would be obvious to provide the teachings of Serikawa into the system of Canada, Fiorletta, and Pearson to “prevent collision.” What the Office Action describes is the motivation for Serikawa to create the invention of Serikawa. This is not a motivation to

combine the teachings of Serikawa with any other reference. The applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine or modify. In the absence of objectively verifiable motivation to modify and/or combine the art or record, no *prima facie* case of unpatentability has been established. Accordingly, the applicants respectfully request the Examiner allow claim 13 for at least this reason.

The Office Action, at page 7, cites applicants' previous remarks, dated July 26, 2004 in the mistaken belief that this is an admission that Serikawa teaches tearing down a data traffic channel in response to detecting a power failure. This is a mischaracterization of the applicants' remarks and mischaracterization of the cited section of Serikawa. (See column 36, lines 49-58.) The applicants' comments of July 22, 2004 and cited in the present Office Action were addressing a rejection of claims 18-21 and are unrelated to the current rejection of claim 13. Furthermore, applicants merely stated that Serikawa includes a description "of inhibiting transmission of the C channel in response to an event such as a power failure." Indeed, Serikawa discusses such a process in column 36, lines 48-58. However, column 36, lines 48-58 of Serikawa does not describe tearing down a channel in response to the detection of a power failure. Rather, Serikawa describes a process that occurs after power has been restored. When power has been restored, the malfunctioning units will all rush to re-register, which may cause undesirable collisions. To help minimize collisions, the system of Serikawa uses a transmission inhibition signal to temporarily prevent already registered units from transmitting on the C channel to thereby prevent undesirable collisions. Nothing in this section refers to tearing down a data channel in response to the detection of a power failure.

Claims 18-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada, Serikawa, and Patel. The applicants respectfully traverse this rejection and request reconsideration. As noted above, the Office Action provides no *prima facie* case of obviousness in light of the combination of Canada, Serikawa, and Patel. It should be noted that these three patent references have been placed in different patent classifications by the U.S. Patent Office and have no

overlapping classes or fields of search. One skilled in the art would be unlikely to select three patents from three different classes to achieve the combination suggested in the Office Action.

In addition, the Office Action incorrectly asserts that Serikawa teaches tearing down a data traffic channel “in response to detecting that the power failure has occurred” and cites column 36, lines 49-58 in support of that assertion. The Office Action further places significance on the word “after” that appears in this passage at line 53. It is unclear why the word “after” is considered significant, but the passage refers to a process that occurs after power has been restored. Specifically, Serikawa is referring to the re-registration of the malfunctioning units after power has been restored. In column 36, lines 49-58, Serikawa describes a process by which already registered units are temporarily inhibited from transmitting to allow re-registration without the occurrence of over-the-air collisions that might otherwise occur. This does not teach or suggest tearing down a data traffic channel in response to detecting a power failure, as recited in claim 18.

The Office Action acknowledges that the combination of Canada and Serikawa do not disclose polling the wireless transceiver for information in response to the detection of a power failure and states that Patel teaches such a process. The Office Action further states that it would be obvious to one skilled in the art to combine the teaching of Patel into the system of Canada and Serikawa “in order to rationalize the data processing by transmit the accumulated data.” (See Office Action, page 9.) The cited section of Patel, column 1, lines 1-12, makes no such statement. Patel describes the technical field in which “a location independent personal communications system utilizes a radio messaging system in existing public and cellular telephone communications systems to enable a caller to contact a system subscriber at any location by dialing a single personal telephone number.” (See Patel, column 1, lines 1-12.) Furthermore, it appears that the Office Action is merely describing the motivation for Patel to invent the system of Patel, but offers no objectively verifiable evidence of the motivation to combine Patel with Canada and Serikawa. The applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine and/or



modify the references. In the absence of objectively verifiable motivation to modify and/or combine the art of record to reach the applicants' claims at issue, no *prima facie* case of unpatentability has been established. Accordingly, applicants respectfully request the Examiner allow claims 18-21 for at least this reason.

Claims 22-25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Canada and Gehrig. The applicants respectfully traverse this rejection.

It should be noted that Canada and Gehrig have been classified by the U.S. Patent Office in different classes and in different fields of search that have no overlap. One of ordinary skill in the art is unlikely to select two patent references from two completely different patent classes to achieve the combination suggested in the Office Action.

The Office Action states, at page 10, that Canada does not disclose detecting a communication failure on a data traffic channel and polling the wireless transceiver unit for information in response to detecting the communication failure and asserts that Gehrig provides such teaching. As discussed below, this is a mischaracterization of Gehrig. In addition, the Office Action asserts that it would be obvious to one of ordinary skill in the art to combine the teaching of Gehrig with the system of Canada "to provide a method and device for communication in traffic guidance systems in that the data and voice channels reserved for traffic operation can be better utilized." The Office Action is describing a motivation for Gehrig to create the invention of Gehrig (*i.e.*, an automobile guidance system), but provides no motivation for combining the teachings of Gehrig with those of Canada. The applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine and/or modify. In the absence of objectively verifiable motivation to modify and/or combine the art of record to reach the applicants' claims at issue, no *prima facie* case of unpatentability has been established. Accordingly, applicants respectfully request that the Examiner allow claims 22-25 for at least this reason.

Furthermore, even if one were to combine the references in the manner suggested in the Office Action, they do not teach or suggest the claimed invention. The

Office Action mischaracterizes Gehrig at column 6, lines 33-49, as allegedly detecting a communication failure and polling the wireless unit in response to detecting the communication failure on the data traffic channel. This is incorrect. The section of Gehrig cited in the Office Action merely states that minimal equipment expenditures in the vehicle may not result in guaranteed operation in accordance with the described method and device. As a result of cyclic monitoring of the polling signal transmitted by the master terminal once per polling cycle, time losses or undesired interruptions of communications can occur. It is important to note that Gehrig does not suggest polling in response to the detection of a communication failure. Rather, Gehrig describes a process by which infrequent polling may result in the loss of data. To overcome this problem, Gehrig suggests an implementation utilizing two receivers, which is described at column 6, lines 50-66. These processes do not teach polling in response to the detection of a communication failure. Accordingly, claims 22-25 are clearly allowable over the combination of Canada and Gehrig.

Claims 26-28 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Canada and U.S. Patent No. 6,108,785 to Poisner. The applicants respectfully traverse this rejection. It should be noted that two references cited in the Office Action have been classified by the U.S. Patent Office in different classifications and different fields of search with no overlapping classes and no overlapping fields of search. One of ordinary skill in the art is unlikely to combine two references from two completely unrelated classes, as suggested in the Office Action.

Even if, *arguendo*, one combined Canada and Poisner in the manner suggested in the Office Action, it does not teach or suggest the claimed invention. The Office Action, at page 11, asserts that Canada teaches a process of receiving information from an available wireless transceiver unit at random points in time and cites column 14, lines 14-17 of Canada in support of that assertion. This is incorrect and is a mischaracterization of Canada. The cited section of Canada is describing an installation process that can be terminated and resumed at any time. This is unrelated to the process of receiving information from a wireless transceiver unit at a random point in time over a shared channel in response to sending an information request message, as recited in claim 26.

While the courts require that claims be considered as a whole, the Office Action appears not only to break the claim down into individual elements, but to cite two disparate references for each teaching only a part of a single element. Claim 26 recites *inter alia* “receiving information from each available wireless transceiver unit at random points in time over a shared channel in response to sending the information request message.” The Office Action cites a brief passage in Canada as supporting the concept of receiving information at random points in time and ignores the limitation that the receipt of information at random points in time is in response to sending the information request message. Canada describes a registration process that may be initiated at any time. However, it is clear that the remote unit initiates the registration process and no data is sent at a random point in time in response to sending an information request message, as recited in claim 26. The Office Action cites Poisner as teaching sending data in response to an information request message. However, Poisner does not teach or even suggest that any response is sent at a random point in time. Thus, the Office Action has clearly ignored the limitation in the final element of claim 26 by citing two unrelated references as allegedly suggesting a single claim element.

Furthermore, Poisner is directed to a security algorithm in a computer system and is not related to telecommunications, wireless communications units, or a wireless communication network. As such, Poisner is unrelated to claim 26 and appears to be cited only on the basis of using the claim language as a roadmap to find and combine unrelated references. It is inappropriate to combine a tiny portion of Canada related to registration with an unrelated reference for computer security to reach the conclusion that claim 26 is obvious. There is no objectively verifiable evidence in either reference that suggests the modification or combination asserted in the Office Action. The applicants respectfully request that the Examiner point to any objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine and/or modify the references. In the absence of objectively verifiable motivation to modify and/or combine the art of record, no *prima facie* case of unpatentability has been established. Accordingly, the applicants respectfully request that the Examiner allow claims 26-28 for at least this reason.

Claims 29-31 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Canada and U.S. Patent No. 5,526,357 to Jandrell. The applicants respectfully traverse this rejection. It is noted that the two references have been classified by the U.S. Patent Office in entirely different classes and fields of search with no overlap. One skilled in the art would be highly unlikely to combine two references from completely different classifications in the manner suggested in the Office Action.

The Office Action states that it would be obvious to combine the teaching of Jandrell with the system of Canada “to provide a system for communication efficiency and minimizing the effect of multipath interference.” (See Office Action, pages 12-13.) The Office Action provides a motivation for Jandrell to create the invention of Jandrell, but does not provide any motivation for combining the references in the manner suggested in the Office Action. The conclusion of obviousness is a bare assertion based on the improper use of the claims as a roadmap for the discovery of references. The applicants respectfully request that the Examiner point to objectively verifiable evidence or supply an affidavit setting forth the objectively verifiable evidence of such motivation to combine and/or modify the references in the manner asserted in the Office Action. In the absence of objectively verifiable motivation to modify and/or combine the art of record to reach the applicants’ claims at issue, no *prima facie* case of unpatentability has been established. Accordingly, applicants respectfully request that the Examiner allow claims 29-31 for at least this reason.

Furthermore, even if, *arguendo*, the references were combined in the manner suggested in the Office Action, the references do not suggest the invention recited in claim 29. Specifically, the Office Action asserts, on page 12, that Jandrell teaches delaying for a random period of time in response to receiving an information request message, and cites column 29, lines 5-9 of Jandrell as supporting that assertion. This is incorrect. The cited section of Jandrell is describing a well known computer access protocol in which a device wishing to transmit data selects a time slot and simply attempts the transmission. This is sometimes referred to as an ALOHA protocol. If the data is received, the transmission was successful. If another transmitter selected the same time slot, a collision occurs and the data is not received. In that instance, the transmitter randomly selects another time slot and attempts the

transmission a second time. However, such random transmissions are not in response to receiving an information request message, as recited in claim 29. The references, taken alone or in combination, do not teach or suggest the method of claim 29. Accordingly, claims 29-31 are clearly allowable over the combination of Canada and Jandrell.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. In an effort to advance prosecution of this case, the Examiner is invited to contact the undersigned at (206) 628-7640.

Respectfully submitted,

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